APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/586,771	05/10/2007	Sebastian Nystrom	BKS.018.WUS	1601

76385   7590   07/23/2009
Hollingsworth & Funk, LLC
8009 34th Avenue South
Suite 125
Minneapolis, MN 54425

EXAMINER
BASIT, ABDUL

ART UNIT	PAPER NUMBER
3694	

MAIL DATE	DELIVERY MODE
07/23/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
	10/586,771	NYSTROM ET AL.
Office Action Summary	Examiner	Art Unit	
	ABDUL BASIT	3694	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *20 July 2006*.
2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-27* is/are pending in the application.
    4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) *1-27* is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a) ☐ All   b) ☐ Some * c) ☐ None of:
      1. ☐ Certified copies of the priority documents have been received.
      2. ☐ Certified copies of the priority documents have been received in Application No. _____.
      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date *7/20/06*.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Objections

1.   Claims 1-27 are objected to because of the following informalities: The

beginning of each claim does not include "A," "An," or "The." Appropriate correction is

required.

Claim Rejections - 35 USC § 101

1.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of
> matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the
> conditions and requirements of this title.

Claims 1-11 are rejected under 35 U.S.C. 101 because the claimed invention is

directed to non-statutory subject matter. According to In re Bilski 545 F.3d 943 (Fed.

Cir. 2008), a method claim must either be tied to a particular machine or transform an

article into a different state or thing. Claim 1 fails to adhere to Bilski.

Further, claim 1 is rejected under 35 U.S.C. 101 for being a claim for instructions

without any computer medium or even how the instructions are used for a practical

application.

Additionally, claim 14 is rejected under 35 U.S.C. 101 for claiming a computer

data signal. Signals are not patentable subject matter.

Claim Rejections - 35 USC § 112

2.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly
> claiming the subject matter which the applicant regards as his invention.

3.   Claims 1-11 are rejected under 35 U.S.C. 112, second paragraph, as being

indefinite for failing to particularly point out and distinctly claim the subject matter which

applicant regards as the invention. The claim language is vague and unclear with

significant shortcomings. The Applicant respectfully requested to make changes to

make the claim language understandable.

        For example, in claim 2 recites "scanning an environment." It is unclear by the

claim language what the Applicant means by scanning an environment. Claim 5 recites

"data records relates to an information out of a set of information." It is unclear what

information is being sought.

4.   Claim 11 is rejected under 35 U.S.C. 112, second paragraph for depending on a

different class. Claim 11 is a computer readable medium, while claim 1 is a method.

Claim Rejections - 35 USC § 102

4.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5.   Claims 1-27 are rejected under 35 U.S.C. 102(e) as being anticipated by Fuzell-

Casey (US Pat. Pub. No. 2004/0039661).

Regarding claim 1:

Fuzell Casey teaches a method for automated context information based selective data

provision by identification means, comprising:

wirelessly context information from an external source; _(see at least Fig. 2, paragraphs_

_24-29)_

a data record out of a plurality of data records, wherein said plurality of data records are

maintained for selecting; wherein said selecting of said data record is performed in

accordance with said context information; _(see at least Fig. 2, paragraphs 24-29)_

supplying said selected data record to said identification means; and providing said

prepared data record as an identification information by said identification means for

being retrievable wirelessly by an external entity. _(see at least Fig. 2, paragraphs 24-29)_

Regarding claim 2:

Fuzell-Casey teaches a method according to claim 1, comprising scanning an

environment for said external source. _(see at least Fig. 2, paragraphs 24-29)_

Regarding claim 3:

Fuzell-Casey teaches a method according to claim 1 comprising

analyzing said context information for selecting said data record. _(see at least Fig. 2,_

paragraphs 24-29)

Regarding claim 4:

Fuzell-Casey teaches a method according to claim 3, wherein said analyzing comprises

at least one operation out of said operations including at least:

extracting one or more commands instructing to select said data record; *(see at least*

Fig. 2, paragraphs 24-29)

extracting an information item from said context information to be compared with data

items comprised by said data records in order to allow selection of said data record;

(see at least Fig. 2, paragraphs 24-29) and

extracting an information item from said context information to be compared with

association information in order to allow selection of said data record. *(see at least Fig.*

2, paragraphs 24-29)

Regarding claim 5:

Fuzell-Casey teaches a method according to claim 1 wherein each of said data records

relates to an information out of a set of information including at least payment related

information, loyalty card related information, credit card related information, a debit card

related information, a prepaid card related information, a coupon related information, a

voucher related information and electronic ticket related information. *(see at least Fig. 2,*

paragraphs 24-29)

Regarding claim 6:

Fuzell-Casey teaches a method according to claim 1 wherein said preparing comprises:

configuring an identification means with said selected data record for providing said

selected data record as said identification information. *(see at least Fig. 2, paragraphs*

24-29)

Regarding claim 7:

Fuzell-Casey teaches a method according to claim 1 wherein said providing of said

selected data record as said identification information is operable with a radio frequency

identification means, from which said selected data record is wirelessly retrievable by a

corresponding external counterpart identification means. *(see at least Fig. 2,*

paragraphs 24-29)

Regarding claim 8:

Fuzell-Casey teaches a method according to claim 1 wherein said providing of said

selected data record as said identification information is operable with a visual encoding

means, from which said selected data record is retrievable by a corresponding external

counterpart visual scanning means. *(see at least Fig. 2, paragraphs 24-29)*

Regarding claim 9:

Fuzell-Casey teaches a method according to claim 1 comprising:

revoking said provision of said selected data record in consequence of at least one

operation out of a set of operations including:

running down a predefined interval in time; *(see at least Fig. 2, paragraphs 24-29)*

exceeding a predefined moment in time; *(see at least Fig. 2, paragraphs 24-29)* and

detecting that said external counterpart identification means has retrieved said

identification information representing said selected data record. *(see at least Fig. 2,*

paragraphs 24-29)

Regarding claim 10:

Fuzell-Casey teaches a method according to claim 1 wherein said identification means

is operable with a reader mode and a transponder mode, comprising

operating said identification means in said reader mode for said acquisition of said

context information; *(see at least Fig. 2, paragraphs 24-29)* and

operating said identification means in said transponder mode for provision of said

selected data record. *(see at least Fig. 2, paragraphs 24-29)*

Regarding claim 11:

Fuzell-Casey teaches <u>a computer-readable medium having computer-executable</u>

<u>program code sections stored thereon</u> Computer program product for executing a

method for automated context information based selective data provision for

identification means, the comprising program code sections carrying out the steps of

claim 1 when said program <u>code</u> sections are-is run on a computer, a microprocessor

based device, a terminal, a network device, a mobile terminal or a mobile

communication enabled terminal. *(see at least Fig. 2, paragraphs 24-29)*

12. (Cancelled)

13. (Cancelled)

Regarding claim 14:

Fuzell-Casey teaches a computer data signal embodied in a carrier wave and

representing instructions, which when executed by a processor cause the steps of claim

to be carried out. *(see at least Fig. 2, paragraphs 24-29)*

Regarding claim 15:

Fuzell-Casey teaches a portable terminal enabling automated context information based selective data provision for identification means, comprising:

acquisition means adapted for wireless acquiring context information from an external source; *(see at least Fig. 2, paragraphs 24-29)*

selection means adapted for selecting a data record out of a plurality of data records, wherein said plurality of data record is maintained by the portable terminal for selection; wherein said selecting of said data record is operable in accordance with said context information; *(see at least Fig. 2, paragraphs 24-29)* and

configuration means adapted for preparing said selected data record for further processing; *(see at least Fig. 2, paragraphs 24-29)*

wherein said identification means is adapted for providing said selected data record as an identification information for being wirelessly retrievable. *(see at least Fig. 2, paragraphs 24-29)*

Regarding claim 16:

Fuzell-Casey teaches a portable terminal according to claim 15, wherein said acquisition means is adapted for scanning an environment for said external source. *(see at least Fig. 2, paragraphs 24-29)*

Regarding claim 17:

Fuzell-Casey teaches a portable terminal according to claim 15 wherein the identification means is coupled electrically or wirelessly to said portable terminal at least

for a time.

Regarding claim 18:

Fuzell-Casey teaches a portable terminal according to <u>claim</u> 15 comprising:

analysis means adapted for analyzing said context information comprises at least one

means out of said means including at least:

extraction means adapted for extracting one or more commands and/or for extracting an

information item from said context information, wherein said one or more commands

instruct to select said data record; *(see at least Fig. 2, paragraphs 24-29)*and

comparison means adapted for comparing said information item with data items

comprised by said data records and/or for comparing said information item with

association information such that the selection is operable with comparison results. *(see*

at least Fig. 2, paragraphs 24-29)

Regarding claim 19:

Fuzell-Casey teaches a portable terminal according to <u>claim</u> 15 comprising:

revocation means adapted for revoking said provision of said selected data record in

consequence of a signal generated by at least one means out of said means including

at least:

 timer means adapted to generate said signal in case a predefined interval in time has

run down and/or in case a predefined moment in time has been exceeded; *(see at least*

Fig. 2, paragraphs 24-29) and

 detection means adapted to detect whether said external counterpart identification

means has retrieved said identification information representing said selected data

record. *(see at least Fig. 2, paragraphs 24-29)*

Regarding claim 20:

Fuzell-Casey teaches a portable terminal according to <u>claim</u> 15 , wherein said

identification means is a radio frequency identification (RFID) means. *(see at least Fig.*

2, paragraphs 24-29)

Regarding claim 21:

Fuzell-Casey teaches a portable terminal according to <u>claim</u> 15wherein said

identification means is visual encoding means. *(see at least Fig. 2, paragraphs 24-29)*

Regarding claim 22:

Fuzell-Casey teaches a portable terminal according to <u>claim</u> 15 wherein said

identification means is operable with a reader mode and a transponder mode; *(see at*

least Fig. 2, paragraphs 24-29) wherein said identification means is operable with said

reader mode for said acquisition of said context information and said identification

means is operable with said transponder mode for provision of said selected data

record. *(see at least Fig. 2, paragraphs 24-29)*

Regarding claim 23:

Fuzell-Casey teaches a portable terminal according to <u>claim 15 </u>wherein at least one of

said means is implemented on the basis of a code section, which is adapted to perform

a function of said means, when carried out by a processing means comprised by said

portable terminal. *(see at least Fig. 2, paragraphs 24-29)*

Regarding claim 24:

Fuzell-Casey teaches a system enabling for automated context information based

selective data provision for identification means, comprising: a source providing context

information; *(see at least Fig. 2, paragraphs 24-29)*

a counterpart identification means adapted for acquiring identification information from

said identification means; *(see at least Fig. 2, paragraphs 24-29)* and

a portable terminal comprising:

acquisition means adapted for wireless acquiring context information from said external

source; *(see at least Fig. 2, paragraphs 24-29)*

selection means adapted for selecting a data record out of a plurality of data records,

wherein said plurality of data record is maintained by the portable terminal for selection;

*(see at least Fig. 2, paragraphs 24-29)*wherein said selecting of said data record is

operable in accordance with said context information; and

configuration means adapted for preparing said selected data record for further

processing; *(see at least Fig. 2, paragraphs 24-29)*

wherein said identification means is adapted for providing said selected data record as

said identification information for being wirelessly retrievable. *(see at least Fig. 2,*

paragraphs 24-29)

Regarding claim 25:

Fuzell-Casey teaches a system according to claim 24, wherein said portable terminal is a portable terminal according to claim 15. *(see at least Fig. 2, paragraphs 24-29)*

Regarding claim 26:

Fuzell-Casey teaches a system according to claim 24 wherein said counterpart identification means is comprised by a point of sales, a ticket checkpoint or a gate entrance. *(see at least Fig. 2, paragraphs 24-29)*

Regarding claim 27:

Fuzell-Casey teaches a system according to claim 24 wherein said source is an identification means storing said context information. *(see at least Fig. 2, paragraphs 24-29)*

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ABDUL BASIT whose telephone number is 571-272-5506. The examiner can normally be reached on Flex.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 571-272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Ab

/James P Trammell/
Supervisory Patent Examiner, Art Unit 3694